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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,795	05/21/2004	Mathias Schafforz	P24971	7973
7055 7590 10/02/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER LAZORCIK, JASON L	
			ART UNIT 1731	PAPER NUMBER
			NOTIFICATION DATE 10/02/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

Application No.

10/849,795

Applicant(s)

SCHAFFORZ, MATHIAS

Examiner

Jason L. Lazorcik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 to 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants independent claims 13 and 21 have been amended to include a limitation directed to the "suction channel" wherein said suction channel is arranged "to suction off the at least one wrapping material strip". At the outset, Applicant is advised that the newly added limitation is construed as a statement of intended use, and that it is entirely unclear how said the amended language further limits the structure of the claimed device. Specifically, the limitation "to suction off..." is understood as functional language which does not clearly add patentable weight to the claimed structure or to distinguish the claimed structure over that of the prior art.

The MPEP §2115 [R-2] provides clear guidance on this issue and states in part that;

"Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of

material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963))."

Of equal importance, Applicants newly added limitation renders the particular metes and bounds of the claim unclear and indefinite. It is unclear to the Examiner precisely what Applicant intends by the functional term "suction off". Specifically, the language indicates that the wrapping material is "suctioned off" but fails to conclude the limitation by indicating to where said material is "suctioned off to" or what is "suctioned off" therefrom. For example, it would be reasonable to interpret the instant claim language as simply applying suction or vacuum to the wrapping material strip to secure said strip in a particular location. Alternately, the claim may be construed to mean redirecting the wrapping material strip away or "off" of the conveyor path to an alternate conveyance path. Further, the claim may be reasonably interpreted to mean suctioning some material off from the wrapping material. These divergent yet equally valid interpretations of Applicants functional language necessarily result in divergent apparatus structures. For at least this reason, the particular metes and bounds of the claimed apparatus are rendered unclear and indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **13, 14, 17, 22, and 26-27** are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No 5,779,184 to Kaufmann et al. ("Kaufmann").

As for claim 13, figure 1 of Kaufmann teaches a feed element [paper roll 2], a severing element [splicing point blade 10], a fixing element [guide roll 6], and a suction channel [suction box 4] to "suction off" or "suck down" uniformly across the entire width of the paper (Column 1, lines 54-58).

As for claim 14, the conveyor path extends from a wrapping material strip supply [splicing roll 10] to said feed element.

As for claim 17, figure 1 of Kaufmann shows a second severing element [cut off blade 10']

As for claim 26, figure 1 of Kaufmann teaches a conveyor path [path of paper travel between paper roll 2 and guide roll 6], a suction channel [suction box 4], a severing element [splicing point blade 10], and a fixing element [guide roll 6].

As for claims 22 and 27, the fixing element is arranged up stream of the severing element.

Claims **13, 15, and 23-30** are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 4,648,409 to Mattei ("Mattei").

As for claim 13, figure 2 of Mattei teaches a feed element [roller 10], a severing element [knife 34], a fixing element [outer shell 11], and a suction channel [suction unit 35].

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As for claims 15 and 23-25, Mattei teaches a cigarette rod maker for making rods of smokeable material [abstract].

As for claim 16, figures 2-4 of Mattei shows an air nozzle<sup>1</sup> [restriction leading to suction unit 35] in the suction channel.

As for claim 26, figures 2-4 of Mattei teach an apparatus with a suction channel [suction unit 35], a conveyor path [path of paper 4 in figure 2], a severing element [knife 34], and a fixing element [roller 10].

As for claim 27, the fixing element is positioned upstream of the fixing element.

As for claims 28-30, multiple air nozzles [air suction conduits 13] perform the claimed functions of the first through third air nozzles claimed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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<sup>1</sup> Nozzle is interpreted broadly to include such meanings as 'a short tube or duct that usually tapers or has a restriction.'

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim **18** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufmann as applied to claim 17, further in view of United States Patent No. 5,314,132 to Ando et al. ("Ando"). Ando discloses that which is not expressly disclosed by Kaufmann, namely that individual severing elements may have individual air nozzles as part of the severing means [col. 1 lines 30-45]. At the time of the invention, it would have been obvious to a person having ordinary skill in the art of handling paper webs to use the knife air jet combination of Ando [col. 1 lines 30-45] as the second severing element in Kaufmann because Ando teaches such means in connection with moving webs of paper, i.e. teaching the combination as a substitute for a blade alone [col. 1 lines 30-45]. Ando and Kaufmann are analogous because both relate to severing traveling webs of paper.

#### ***Response to Arguments***

Applicant's arguments, see page 8-9, filed July 20, 2007, with respect to the rejection of claims 17-21 under 35 U.S.C. §112, second paragraph, have been fully considered and are persuasive. The instant rejection of claims 17-21 under §112, second paragraph has been withdrawn.

Applicant's arguments traversing the rejection of claims under 35 U.S.C. §102(b) filed July 20, 2007 have been fully considered but they are not persuasive.

Applicant argues that Kaufmann does not “arguably disclose that suction box (4) is structured and arranged to suction off the at least one wrapping material strip. Examiner strongly disagrees. As set forth in the above rejection, Kauffman teaches the the “paper web is sucked down uniformly across its entire width” (Column 1, lines 54-59) which clearly reads upon applicants claimed arrangement to “suction off”.

Additionally, Applicant is directed to the preliminary comments directed to patentable weight afforded to functional language in apparatus claims set forth in the above rejection under 35 U.S.C. §112, second paragraph (also reference MPEP §2115 [R-2]). In short, Applicants newly added functional limitation fails to unambiguously distinguish the claimed structure over the structure disclosed in the Kauffman reference.

Applicant next argues against the rejection of claims 14, 17, 22, and 27 stating that the claimed invention “recites additional features that further define the present invention”, however Applicant fails to present a clear argument regarding how the claimed invention is patentably distinguished over the prior art structure. Therefore, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Next Applicant presents arguments directed against the applicability of the Mattei reference under 35 U.S.C. §102(b). Applicant begins by acknowledging that Mattei



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provides a suction channel "provided to...hold a paper web during a cutting procedure". However, following the similar line of argument used against the Kauffman reference, Applicant argues that "there is no arguable structure of suction unit 35 described by Mattei that would even remotely suggest that this device is able to suction off a wrapping strip". Examiner strongly disagrees.

According to Applicants own admission, the Mattei structure provides suction force to secure the paper web to the roller (32). Where the term to "suction off" is reasonably interpreted to mean applying vacuum to secure an object, it is the Examiners express position that Mattei's application of suction or vacuum to the web in order to secure said web properly reads upon applicants functional limitation.

Further, Applicant is again directed to the preliminary comments directed to patentable weight afforded to functional language in apparatus claims set forth in the above rejection under 35 U.S.C. §112, second paragraph (also reference MPEP §2115 [R-2]).

Applicant next argues against the rejection of claims 15, and 23-25, and 27-30 stating that the claimed invention "recites additional features that further define the present invention", however Applicant fails to present a clear argument regarding how the claimed invention is patentably distinguished over the prior art structure. Therefore, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically

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pointing out how the language of the claims patentably distinguishes them from the references.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L. Lazorcik whose telephone number is (571) 272-2217. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLL

  
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